

## **REMARKS**

In the Final Office Action dated January 21, 2010, claims 1, 6, 9, 60-66, 70-73, and 75-76 were rejected under 35 U.S.C. § 102(b) as anticipated by *Hoy et al.* (U.S. Patent No. 5,878,947). Claims 2 and 4 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Hoy et al.* as applied to claims 1, 6, 9, 60-66, 70-73, and 75-76. Claims 67-69, 74, and 77 were allowed. Upon entry of this Amendment Under 37 C.F.R. § 1.116, claims 1, 64, and 67 will have been amended, and claims 1-2, 4, 6, 9, and 60-77 will be pending in this application.

### **Response to Objections:**

Claims 1, 64, and 67 were objected to under 37 C.F.R. § 1.75(i) as lacking proper line indentation. Claims 1, 64, and 67 have been amended by this Amendment Under 37 C.F.R. § 1.116 to address this claim objection. Accordingly, the objection of claims 1, 64, and 67 should be withdrawn.

### **Response to Rejections Under 102 and 103:**

Although the Examiner clarified his rejections in the Final Office Action by separating the 102 and 103 rejections, the Office Action dated January 21, 2010 should not have been made final. The improper rejection form from the combination 102/103 rejections asserted in the August 19, 2009 Office Action were inadequate to properly apprise Applicant of the basis of the applied rejections. Specifically, the improper combination rejection failed to apprise which elements were in *Hoy et al.* (and thus allegedly anticipated by *Hoy et al.*) and which elements were missing from *Hoy et al.* (and thus allegedly obvious over *Hoy et al.*). Applicant was unable to respond fully to the rejections by not allowing traversal of elements the Examiner was relying on as anticipatory as distinct from those elements the Examiner was relying on as rendering the claims obvious. Thus, making the Office Action dated January 21, 2010 final was immature

since the rejected claims have only received a clear rejection once. Accordingly, for at least this reason, the finality of the rejection should be withdrawn.

Regardless of whether the claims have been properly twice rejected, the rejections based on *Hoy et al.* fails to teach or suggest each and every element of the claims. For example, claims 1 and 64 recite that “the first portion being removable from the carton.” *Hoy et al.* cannot anticipate at least this element since the stop 56 of *Hoy et al.* is formed from strips 58 and 60, which are intended to “provide a stop outwardly of the package to more positively retain the cans until removed one at a time” (see column 1, lines 49-52 of *Hoy et al.*). The stop 56 of *Hoy et al.* cannot be removed from the carton as claimed without rendering *Hoy et al.* unsatisfactory for its intended purpose of providing a dispensing feature with a retaining means to retain one can at a time (column 1, lines 53-62) (see MPEP 2143.01 (V), which specifies that rendering the prior art unsatisfactory for its intended purpose fails to support a case for obviousness). Further, modifying *Hoy et al.* to remove the stop would change the principle of operation of *Hoy et al.*, since removing the stop would enable the cans to roll out of the carton without being retained, contrary to a stated purpose of *Hoy et al.* (see column 1, line 65 through column 2, line 6) (see also MPEP 2144.03(VI), which specifies that changing the principle of operation of a reference fails to support a prima facie case of obviousness). Thus, rejections based on obviousness by *Hoy et al.* as proposed by the Examiner are not supported by *Hoy et al.*.

Even further, the Final Office Action fails to provide a teaching or suggestion to modify *Hoy et al.* to reach claims 2 and 4 as rejected therein. Applicants specifically traversed any single reference rejection under 35 U.S.C. § 103 based solely on *Hoy et al.*. MPEP 2144.03(C) specifies that once an Applicant timely traverses a rejection based on a single reference, the burden shifts to the Examiner to provide a teaching or suggestion for the proposed modification

of a single reference. The Office Action dated January 21, 2010 entirely fails to provide such required teaching or suggestion. Accordingly, the rejections under 35 U.S.C. § 103 of claims 2 and 4 based on *Hoy et al.* alone fail to provide a prima facie case of obviousness, rejections applied thereto are improper, and the finality of these rejections should be withdrawn. If, however, the Examiner continues to reject the claims under final, Applicants reserve the right to appeal such rejections

Applicants appreciate an indication of allowability of claims 67-69, 74, and 77. However, Applicants believe all claims are allowable over *Hoy* and request an indication thereof. The dependent claims recite additional elements that are not taught or shown by the cited references and are allowable on their own merits. Additionally, the dependent claims are allowable as being dependent upon allowable independent claims and inheriting such allowable characteristics thereof.

The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. 09-0528.

Respectfully submitted,

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Date

Keats A. Quinalty  
Keats A. Quinalty  
Registration No. 46,426

Customer No. 26158  
WOMBLE CARLYLE SANDRIDGE & RICE, PLLC  
P.O. Box 7037  
Atlanta, Georgia 30357-0037  
(404) 879-2423 (telephone)  
(404) 879-2923 (facsimile)  
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